

REMARKS/ARGUMENTS

Prior to entry of this amendment, claims 1-20 were pending in the application. A Final Office Action mailed June 8, 2006, rejected claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite. Finally, the Office Action rejected claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by Rivette (US 2003/0046307). This amendment amends claims 1-17, 19 and 20 and adds new claim 21. Hence, after entry of this amendment, claims 1-21 will stand pending for examination.

Interview summary

The applicants appreciate the courtesy and professionalism shown by the Examiner during the telephonic interview held between the Examiner and the undersigned on October 24, 2006. During that interview, the undersigned explained why the Rivette reference does not teach or suggest the elements of any pending claim. The Examiner stated that the claims did not clearly point out the features of the invention believed to be novel over the cited reference. Hence, no agreement was reached with respect to the claims.

Claim Amendments

Claim 1 has been amended replace the term “electronic document” with the term “prior art reference” for additional clarity. Support for this amendment can be found throughout the application, including, inter alia, at line 6 on page 3 of the application and at lines 4-8 on page 6 of the application. Claim 1 has also been amended to replace the term “case” with “case file” for additional clarity. Support for this amendment can be found throughout the application, including, inter alia, at lines 29-34 on page 12 of the application

Additionally, claim 1 has been amended to recite “maintaining an association at a computer system between a first set of one or more references and a first case file, wherein the first case file corresponds to a first patent application, and wherein the association between the first set of references and the first case file indicates that each of the references in the first set of

references are relevant to the first patent application,” and “maintaining an association at the computer system between a second set of one or more references and a second case file, wherein the second case file corresponds to a second patent application, and wherein the association between the second set of references and the second case file indicates that each of the references in the second set of references is relevant to the second patent application.” Support for these elements can be found throughout the application, including, inter alia, lines 10-13 on page 25 and lines 13-14 on page 28 of the application, as well as the prior language of claim 1 and the portions of the specification supporting that language.

Claim 1 has been further amended to recite “providing a first interface element that is configured to allow a user to invoke a display of a list of the second set of references,” “receiving, at the computer system, a first input from a user, the first input corresponding to the first interface element,” and “in response to the first input, displaying a list of the second set of references, wherein the display comprises an identifier corresponding to a first reference within the second set of references.” These elements find support throughout the application, including, inter alia, at lines 25-34 on page 28, lines 1-27 on page 29, lines 16-28 on page 31 of the application, and lines 22-34 on page 32 of the application.

Claim 1 also has been amended to recite “providing a second interface element that is configured to allow the user to identify the first reference as being relevant to the first patent application,” “receiving, at the computer system, a second input from the user, the second input corresponding to the second interface element,” “in response to the second input, associating, via an automated process at the computer system, the first reference with the first case file,” and “creating, via an automated process at the computer system, an electronic information disclosure statement for the first patent application, wherein the electronic disclosure statement comprises information corresponding to the first reference.” These elements find support throughout the application, including, in particular, at lines 1-11 on page 33 of the application.

Claim 1 has also been amended to remove claim language rendered redundant by the amendments discussed above. Independent claims 19 and 20 have been amended in similar

fashion to claim 1. Dependent claims 2-17 have been amended for consistency with the amendments to claim 1, from which they depend.

New claim 21 has been added. Support for claim 21 can be found throughout the application, including, inter alia, at lines 9-18 on page 14 of the application.

§ 112 Rejections

The office action rejected claims 1-20 under § 112, ¶ as being indefinite. It is believed that the amendments to the claims address all of the grounds of rejection under § 112, and reconsideration of the amended claims is respectfully requested.

§ 102 Rejections

The office action also rejected claims 1-20 under § 102(e) as being anticipated by Rivette. It is believed, however, that Rivette fails to teach or suggest the elements of the claims, at least as amended by this document. Rivette generally discloses a system for maintaining databases of patents (and non-patent information) and for processing groups of patents (Rivette, abs.) Rivette, however, contains little (if any disclosure) relating to the prosecution of pending applications – instead it is focused on dealing with issued patents. Accordingly, Rivette has no need to deal with information disclosure statements, which, one skilled in the art would appreciate, generally are pertinent only to pending applications, not issued patents. (Indeed, a text search of the Rivette references fails to identify a single mention of an “information disclosure statement”).

Accordingly, Rivette fails at least to teach or suggest “creating, via an automated process at the computer system, an electronic information disclosure statement for the first patent application, wherein the electronic disclosure statement comprises information corresponding to the first reference,” as recited by claim 1, and for this reason—if no other—claim 1 is allowable over Rivette. Moreover, because Rivette is concerned with issued patents, and not pending applications, there could be no reasonable motivation or suggestion to modify Rivette to operate in accordance with this element of claim 1.

Additionally, however, the cited portions of Rivette fail to teach or suggest other elements of claim 1. Merely by way of example, the office action does not identify any disclosure in Rivette that might be interpreted to teach or suggest “providing [an] interface element that is configured to allow the user to identify [a] first [prior art] reference as being relevant to [a] first patent application,” as recited by claim 1. Nor, unsurprisingly, is there identified any teaching or suggestion of “receiving, at [a] computer system, [an] input corresponding to [such an] interface element” or “in response to the . . . input, associating, via an automated process at the computer system, the . . . first reference with [a] case file.”

For at least these reasons, claim 1 is believed to be allowable over Rivette. For at least similar reasons, independent claims 19 and 20 are believed to be allowable. Dependent claims 2-18 and 21 are believed to be allowable at least by virtue of their dependence from allowable base claims.

In addition, many of the dependent claims recite additional novel features not disclosed by Rivette. Merely by way of example, new claim 21 recites, inter alia, “the electronic information disclosure statement comprises a plurality of fields for storing information from the first reference,” “the first reference comprises information corresponding to the plurality of fields,” and “creating the electronic information disclosure statement comprises the information from the first reference and storing the information in the plurality of fields in the electronic information disclosure statement.” As noted above, Rivette fails even to teach or suggest the creation of an information disclosure statement; necessarily, Rivette fails to teach or suggest the process for creating such an IDS recited by claim 21. For at least this additional reason, claim 21 is believed to be independently allowable.

CONCLUSION

In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Application No. 09/919,787

PATENT

Amendment dated: November 8, 2006

Amendment Under 37 CFR 1.114 Request for
Continued Examination

If the Examiner continues to believe that the claims are unpatentable over Rivette (taken either alone or in combination with any other reference) or continues to have any trouble understanding the meaning of the claims, the undersigned respectfully requests a telephone interview to discuss the rejections. The undersigned can be reached by telephone at 303-571-4000 to schedule the telephone interview.

Respectfully submitted,

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